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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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09/672,328

09/29/2000

James A. Belmont

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05/21/2002

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EXAMINER

OH, TAYLOR V

ART UNIT

PAPER NUMBER

1625

DATE MAILED: 05/21/2002

9

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/672,328

Applicant(s)

BELMONT, JAMES A.

Examiner

Taylor Victor Oh

Art Unit

1625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 February 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 6, 7 and 20-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1-4, 6, 7 and 20-31 is/are rejected.
- 7) ☐ Claim(s) 5 and 8-19 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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Final Rejection

The Status of Claims

Claims 1-4, 6-7 and 20-31 have been rejected.

Claims 5 and 8-19 have been objected.

Claim Rejections-35 USC 102

1. Applicants' argument filed 3/12/2002 have been fully considered but they are not persuasive.

Rejection of claims 1-4, 6-7 and 20-28 under 35 U.S.C. 102(b) as being anticipated clearly by Adams et al (US 5,698,016).

Claim Rejections-35 USC 103

2. Rejection of claims 29-31 under 35 U.S.C. 103(a) as being unpatentable over Adams et al (US 5,698,016) in view of Kato et al (US 5,731,115).

The rejection of claims 1-4, 6-7 and 20-28 under 35 U.S.C. 102(b) as being anticipated clearly by Adams et al (US 5,698,016) is maintained for the reasons of the record in paper no. 6.

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The rejection of claims 29-31 under 35 U.S.C. 103(a) as being unpatentable over Adams et al (US 5,698,016) in view of Kato et al (US 5,731,115) is maintained for the reasons of the record in paper no. 6.

Response to the Applicants' Argument

3. Applicants argue the following issues:

1. Adams et al have failed to suggest the presence of at least one steric group attached to the carbon product.
2. Adams et al and Kato et al do not teach or suggest the attachment of both a steric group and an organic ionic group with an amphiphilic group counter ion onto the pigment.

The applicants' arguments have been well taken, but these arguments are traversed.

Concerning the Adams et al reference's failure to suggest the presence of at least one steric group attached to the carbon product, the Examiner disagree. However, the Adams et al do indicate that regarding the organic group attached to the carbon, the organic group can be

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selected from at least one aromatic group or one C₁-C₁₂ alkyl group which is directly attached to the carbon (see col. 5, lines 32-33). Therefore, it reads on the claim.

With respect to the failure of the Adams et al and Kato et al references to teach or suggest the attachment of both the steric group and the organic ionic group with an amphiphilic group counter ion onto the pigment, the Examiner has noted the argument. However, Adams et al do disclose a modified pigment such as carbon black having attached at least one organic group(see col. 5 , lines 28-34) and at least an amphiphilic (see col. 6 ,lines 25-36), which can have a charge opposite to that of the organic ionic group(see col. 1, lines 1-58); furthermore, for the organic group attached to the carbon, the organic group can be at least one aromatic group or one C₁-C₁₂ alkyl group which is directly attached to the carbon (see col. 5, lines 32-33); also, Adams et al have pointed out the formation of a carbon black with a polymeric cationic amphiphile (see col. 20, lines 1-58) such as methyl acrylate, methyl methacrylate, butyl acrylate, styrene (see col . 4 , lines 14-16). Therefore, it reads on the claim.

Regarding to Kato et al reference, it has been used a secondary reference to supplement the primary reference with respect to the limitations such as a print plate containing a substrate, a protective layer , an absorptive layer containing at least one modified pigment , a method of imaging a lithographic print plate using a laser , and a solvent for the removal of portions from the imaged layer. Therefore, if the person having an ordinary skill in the art had desired to improve the properties of the printing plate such as an increased durability of the printing plate, it would have been obvious for the skillful artisan in the art to have motivated to apply Adams et al's modified carbon black with a polymeric cationic amphiphile to the Kato et al 's preparation of the waterless lithographic printing plate as an alternative to the ordinary carbon black with an expectation of a similar success as in the Keto et al's process.

Therefore, the Examiner maintains the rejection of all the claims

Conclusion

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3. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

4.. Any inquiry concerning this communication or earlier communications from the examiner should be directed to T. Victor Oh whose telephone number is (703) 305-0809. The examiner can normally be reached on Monday through Friday from 8:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alan Rotman , can be reached on (703) 308-4698. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4556.

T. Victor Oh


5/18/02



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